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## REMARKS

***Amendment to the Claims***

Claims 1-3 and 5-7 remain open for prosecution and claims 8-10, 12 and 13 are withdrawn but are requested to be rejoined should claims 1-3 and 5-7 be held to be allowable (see MPEP 806.05(c) II. Subcombination Essential to Combination).

***35 U.S.C. 102(b) rejection***

Claims 1-3 and 5-7 were rejected as being anticipated by Lawrence (U.S. Patent 3,860,673).

*Background*

While the applicants appreciate that on occasion an examiner may have a change of opinion or find new references which he believes to serve as the foundation for new rejections, the rejection over Lawrence is not well received by the applicants particularly in light of the delay in answering the applicants after final response of 29 April 2003 which required faxing of the response on at least three separate occasions and for which delay caused the applicants to file a Notice of Appeal.

Lawrence (U.S. Patent 3,860,673) was cited in the third office action non-final by the examiner as being a "newly discovered reference" when in fact this is an old reference from the examiner's very first office action on the merits mailed on 25 June 2002 (Paper No. 8) and was rescinded by the examiner in the final rejection of 13 February 2003 (Paper No. 10).

Not only is Lawrence a "recycled" reference, it was not even used to support an anticipation rejection but used to support an obviousness rejection. Moreover, the obviousness rejection was made against claims which were broader in scope then than they are now (i.e. the former limitation of claim 4 at the time of the first office action on the merits is now part of the present claim 1).

The examiner's use of Lawrence to support a holding of obviousness for claims which were broader in scope than the currently pending claims would appear to be *prima facie* evidence without even considering the

merits of the specific teachings of Lawrence that the applicants' claims are not anticipated by Lawrence especially when considering that no corresponding rejection based on anticipation was made in the first office action on the merits.

*Lawrence does not teach every element of the applicants' invention*

MPEP 2131 states "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Lawrence does not meet this standard.

From the 25 November 2002 response by the applicants, it is again asserted that a person of ordinary skill in the art would not obtain the present invention because the reference contemplates an adhesive that is not solvent-free. Specifically, the reference preferably employs an elastomer as a solution in an organic solvent. See col. 1, lines 65-66. Because the present claims require the adhesive to be a hot-melt (or solvent-free) adhesive, the claims are not anticipated by the cited reference.

*Lawrence does not show the applicants invention in as complete detail as is contained in applicants' claim*

MPEP 2131 also states that to anticipate a claim, the reference must teach every element of the claim, i.e. "The identical invention must be shown in as complete detail as is contained in the...claim. see *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989)." The standard for a proper anticipation rejection is also illustrated in *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972), whereby the reference "*must clearly and unequivocally* disclose the claimed compound or direct those skilled in the art to the compound *without any need for picking, choosing,* and combining various disclosures not directly related to each other by the teachings of the cited reference." *Id.* at 526.

However, the examiner has inadvertently treated the Lawrence reference as though it were part of a scavenger hunt with the applicants' claims serving as a checklist of items to be obtained. Even if *in arguendo* one were to accept that Lawrence "met" all the items of the checklist (i.e. the best possible interpretation of the Lawrence reference which supports the examiner's position), this falls far short of the standard that the "identical invention was shown in as complete a detail as contained in the claim" and requires the skilled artisan to engage in exactly the type of picking and choosing which is not permitted to

determine anticipation.

*Conclusion*

For any of the reasons cited above, i.e. the failure of Lawrence to meet all elements of the claimed invention or the failure of Lawrence to show the applicants invention is as complete a detail as claimed, it is believed that Lawrence does not anticipate the applicants' claimed invention.

***Closing***

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: **29 December 2003**

By: Howard C. Lee
Howard C. Lee